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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,245	09/10/2004	Masafumi Miyakawa	018765-171	9077

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EXAMINER

MULLIS, JEFFREY C

ART UNIT PAPER NUMBER

1711

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/507,245

Applicant(s)

MIYAKAWA ET AL.

Examiner

Jeffrey C. Mullis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9-08/2005/105
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicants' Japanese patent 2001-19932 has not been submitted and has therefore not been considered, MPEP 609.

Applicant's election with traverse of Group I, claims 1, 2, 3, and 5 in the reply filed on 10-11-05 as well as the interview summary of 11-11-05 is acknowledged. The traversal is on the ground(s) that standards applicable to unity of invention are applicable. This is not found persuasive because unity of invention standards have been relied upon as set out in the lack of unity requirement of 9-20-05. It is noted that the term "dependent claim" is not used in the same sense in lack of unity practice as in US practice and a holding of lack of unity for dependent claims (as the term "dependent" is used in US practice) is not precluded as the group II claims are not dependent claims in the sense of lack of unity practice. In any case, rejoinder of claims properly dependent on allowable independent claims (as the term "independent" is used in US practice) will be appropriate. At present the group I and II claims contain some ambiguity as to whether they are properly dependent but applicants are free to amend their claims for clarity such that all of the limitations of the group I independent claim is clearly present in the group II claims.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1, 2, 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites a "surface protecting adhesive film" in the first line thereof but then recites that the adhesive film is formed on a base film and it is thus unclear

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whether applicants are claiming the film or a combination of a film and base film. If applicants are claiming just the adhesive film it is unclear how the base film is intended to limit the claim.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mizutani et al. (JP 09 0255933).

Mizutani discloses examples of a 50 micrometer film having an epoxy crosslinker, NBR (which would have inherently crosslinkable cyano groups and crosslinkable unsaturated groups) and having applicants glass transition values (tan delta). Note table

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1 in paragraph 53. Note that the thermoplastic "C" of patentees contains aromatic group polymers such as in principle could be crosslinked by difunctional materials capable of electrophilic aromatic substitution. It is noted that the instant claims do not actually require the capability of crosslinking by applicants component "C" with applicants "A" and "B" but "A" and "B" are merely recited to have crosslinkable functional groups.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Claims 1, 2, 3 and 5 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bell et al. (US 2005/0158475).

Bell discloses a composition containing an iminated acrylic "a" having low Tg (XK90) in combination with a (low) acid value methacrylic polymer having a high Tg of 105 degrees centigrade and a crosslinker (abstract and paragraph 111). Applicants film thicknesses are disclosed by way of examples in table 1. All of applicants limitation are thus explicitly disclosed by patentees except that it is not explicitly disclosed that the "XK90" acrylic of patentees has applicants' required glass transition temperature of 5 degrees to minus 50 degrees. However, "XK90" is disclosed to be an acrylic and as

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applicants examples disclose that polymers of substantially all acrylate monomer (with a small amount of methacrylate) have applicants glass transition value, it is assumed that the XK90 of patentees also inherently has applicants glass transition values.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Claims 1, 2, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Overbeeck et al in view of (US 2003/0055171) optionally in view of Bell, cited above.

Overbeek discloses a coating composition having two crosslinkable polymers and a crosslinker for both (abstract) and each polymer having applicants glass transition temperatures (paragraph 40). Note paragraphs 172 and 173 for an example meeting all of the limitations of the claims except that applicants film thickness is not disclosed. However use of applicants coating thickness in the composition of Overbeek would have been obvious to a practitioner having an ordinary skill in the art at the time of the

invention in that it requires only routine skill to find the optimum or workable range of a result effective variable and furthermore since Bell also disclose that applicants film thicknesses are workable as a coating absent any showing of surprising or unexpected results.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Seishi et al (JP 11-315259).

Seishi discloses a composition having an alkyacrylate reactive with a crosslinker and having a branched polymer of propylene oxide and ethylene oxide (such as would have reactive hydroxyl end groups. Note paragraphs 68 and 69 in this re and note also applicants' film thickness. Note that the amount of MMA is significantly higher than that used in applicants lower glass transition polymer and therefore presumably has applicants higher Tg. With re to applicants lower Tg polymer, polyether are known for their low glass transition temperatures and therefore presumably applicants lower Tg is inherently possessed by this material.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis at telephone number 571 272 1075.

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11-12-05

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